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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/828,915 | 04/21/2004 | Daniele Fatutto | SAIC 21.081 | 5639 |

26304 7590 04/04/2006

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| EXAMINER |
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BECKER, DREW E

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| ART UNIT | PAPER NUMBER |
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1761

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,915

Applicant(s)

FATUTTO ET AL.

Examiner

Drew E. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claim 13 is withdrawn in view of the newly discovered reference(s) to Bonneau, Smith, and Vialette nee Geolier. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant did not point out where support is found for the new claim limitations.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite,

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failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

6. Claim 1 recites "i.e. for the reduction of...". It is not clear whether this limitation is required, or not.

7. Claim 1 recites the limitation "the solvent". There is insufficient antecedent basis for this limitation in the claim.

8. Claim 1 recites the limitation "the solution to be processed (A)". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 3 recites a third stage "between said first and second stage". It is not clear how the third stage can be "between said first and second stage" if it requires the second permeate created during the second stage.

10. Claim 8 recites the limitation "said volatile acidity". There is insufficient antecedent basis for this limitation in the claim.

11. Claim 8 recites the limitation "the solvent". There is insufficient antecedent basis for this limitation in the claim.

12. Claim 8 recites the limitation "the solution to be processed (A)". There is insufficient antecedent basis for this limitation in the claim.

13. Claim 9 recites "a continuous apparatus consisting of...". It is not clear whether the limitations of parent claim 8 are required due to the use of "consisting".

14. Claim 9 recites the limitation "the same container". There is insufficient antecedent basis for this limitation in the claim.

15. Claims 10-11 recite "it". It is not clear what "it" is.

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16. Claim 13 recites the limitation "the solvent". There is insufficient antecedent basis for this limitation in the claim.

17. Claim 13 recites the limitation "the solution to be processed (A)". There is insufficient antecedent basis for this limitation in the claim.

18. Claim 13 recites "at least one process station" as well as "a single process station". It is not clear how many stations are required.

19. Claim 13 recites the limitation "said initial process station". There is insufficient antecedent basis for this limitation in the claim.

20. Claim 13 recites the limitation "the final process station". There is insufficient antecedent basis for this limitation in the claim.

21. Claim 13 recites "said apparatus comprising:..." as well as "in which said apparatus further comprises:..." It is not clear which components are being claimed as part of the apparatus.

22. Claim 13 recites the limitation "said process station". There is insufficient antecedent basis for this limitation in the claim.

23. Claim 13 recites the limitation "the same process station". There is insufficient antecedent basis for this limitation in the claim.

24. Claim 14 recites "hydroxides, carbonates, tartrates and acetates of sodium, potassium and calcium". It is not clear what compounds are being claimed.

25. Claim 15 recites the limitation "the first stage membrane". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

27. Claims 1, 5, 7, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonneau [Pat. No. 4,499,117].

Bonneau teaches batch process for treating wine by using a first stage comprising ultrafiltration through a membrane to produce a first permeate and a first concentrate (column 4, lines 5-25), a second stage comprising reverse osmosis via a membrane to produce a second concentrate and a second permeate (column 4, lines 26-55), reduction of volatile acidity (column 5, line 11), and the use of pressure (column 3, lines 20 & 45).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau in view of Smith [Pat. No. 5,480,665].

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Bonneau teaches the above mentioned concepts. Bonneau does not recite mixing the second permeate and first concentrate with the initial solution, or a continuous process. Smith teaches a continuous process for treating wine by a first stage comprising filtration through a membrane to produce a first permeate and a first concentrate (Figure 1, #80), a second stage comprising separation to produce a second concentrate and a second permeate (Figure 1, #160), and mixing the second permeate and first concentrate with the initial solution (Figure 1, #210). It would have been obvious to one of ordinary skill in the art to incorporate the continuous recycling of Smith into the invention of Bonneau since both are directed to methods of treating wine, since Bonneau already produced a first concentrate and second permeate (column 4, lines 5-55) as well as mixing of various components (column 4, line 61), and since Smith teaches that mixing the first concentrate and second permeate with the initial solution permitted further separation as well as replacing the desirable components back into the bulk wine (column 2, line 25).

30. Claims 3-4, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau as applied above, in view of Vialette nee Geolier [Pat. No. 4,461,778].

Bonneau teaches the above mentioned concepts and components. Bonneau does not recite an intermediate stage which adds substance to the first permeate, the substances being sodium, potassium, or calcium compounds, means for performing the intermediate stage, and the substances being hydroxides, carbonates, tartrates and acetates of sodium, potassium and calcium. Vialette nee Geolier teaches a process for deacidifying wine by adding calcium carbonate or calcium tartrate to the wine (column 2,

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line 19). It would have been obvious to one of ordinary skill in the art to incorporate the deacidifying step of Vialette nee Geolier into the invention of Bonneau since both are directed to methods of treating wine, since Bonneau already included removal of volatile acids and provided a filtration step (column 4, lines 26-55) capable of removing the crystals produced by Vialette nee Geolier (column 4, line 21), and since the deacidification of Vialette nee Geolier would have further helped remove undesirable malic acid (column 1, lines 4-25).

31. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau, in view of Vialette nee Geolier, as applied above, and further in view of Heess et al [Pat. No. 4,322,446].

Bonneau and Vialette nee Geolier teach the above mentioned concepts. Bonneau and Vialette nee Geolier do not recite an upright container with a grille, a tank, and a siphon. Heess et al teaches a device for treating wine by passing it through a tank with a bottom drain or siphon, the tank containing upright containers comprising grilles that hold calcium tartrate (Figure 1). It would have been obvious to one of ordinary skill in the art to incorporate the structure of Heess et al into the invention of Bonneau, in view of Vialette nee Geolier, since all are directed to wine treating methods and devices, since Bonneau already included filtration, since Vialette nee Geolier already included additives such as calcium tartrate (column 2, line 20), and since the structure of Heess et al provided a means for continuous production with the need for mixing and stirring.

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32. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau, in view of Vialette nee Geolier, as applied above, and further in view of CN 1133882A.

Bonneau and Vialette nee Geolier teach the above mentioned concepts. Bonneau and Vialette nee Geolier do not recite filter means before initial processing. CN 1133882A teaches a device for treating wine including a filter means (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the filtering means of CN 1133882A into the invention of Bonneau, in view of Vialette nee Geolier, since all are directed to devices for treating wine, since Bonneau already included fine filtering such as ultrafiltration and reverse osmosis, and since the preliminary filtering of CN 1133882A would have prevented larger particles from clogging the ultrafiltration membrane of Bonneau.

33. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau, in view of Vialette nee Geolier, as applied above, and further in view of Smith. Bonneau and Vialette nee Geolier teach the above mentioned concepts. Bonneau and Vialette nee Geolier do not recite a first reservoir and a second reservoir. Smith teaches a device for treating wine comprising a first reservoir and a second reservoir (Figure 2, #10 & 310). It would have been obvious to one of ordinary skill in the art to incorporate the reservoirs of Smith into the invention of Bonneau, in view of Vialette nee Geolier, since all are directed to devices for treating wine, since Bonneau and Vialette nee Geolier would have required some means for holding the various solutions and

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components, and since the reservoirs of Smith provided a convenient and efficient means for holding wine and its components.

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ferrarini [Pat. No. 6,913,776], Fricker [Pat. No. 4,792,402], Light [Pat. No. 4,617,127], Dick et al [Pat. No. 4,806,366], and Shrikhande [Pat. No. 4,834,998] teach devices and methods for treating wine.

Response to Arguments

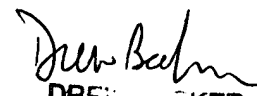
35. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DREW BAKER
PRIMARY EXAMINER
3-29-06